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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,918	12/19/2001	Makoto Kudo	9319S-000296	9967
27572	7590	11/01/2004		
HARNESS, DICKEY & PIERCE, P.L.C. P.O. BOX 828 BLOOMFIELD HILLS, MI 48303				
			EXAMINER	
			MCCARTHY, CHRISTOPHER S	
			ART UNIT	PAPER NUMBER
			2113	

DATE MAILED: 11/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/027,918

Applicant(s)

KUDO, MAKOTO

Examiner

Christopher S. McCarthy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) •
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.
2. The disclosure is objected to because of the following informalities: Paragraph 0024, line 1, reads "The debugger 20 is formed form a debug tool..." The word "form" should read "from". Appropriate correction is required.

Information Disclosure Statement

3. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

The applicant has listed references in paragraphs 0003-0007 which are not contained on any PTO-1449.

Claim Rejections - 35 USC § 102

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4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-5 are rejected under 35 U.S.C. 102(e) as being anticipated by Murray et al. U.S. Patent 6,751,751.

As per claim 1, Murray teaches a debug device comprising a target board having a microcomputer equipped with an on-chip debugging function (figure 1; column 2, lines 22-34; column 1, lines 13-18; column 7, lines 46-48); a debugger connected to the microcomputer via a debug interface terminal provided on the target board and that performs debugging using the on-chip debugging function implemented in the microcomputer (figure 5; column 2, lines 19-21; column 7, lines 16-31); and a break board that monitors signals on an address bus, a data bus and a control bus which are output from the target board, and outputs a break signal when a predetermined break condition is satisfied (column 2, lines 55-58; column 7, lines 34-38; column 3, lines 44-49).

As per claim 2, Murray teaches a debug device according to claim 1, wherein the break board is equipped with a storage section to store break conditions (column 4, lines 46-49), and has a structure in which break conditions are written in the storage section via the target board from the debugger (column 2, lines 19-21).

As per claim 3, Murray teaches a debugging device comprising a target board; a microcomputer disposed on said target board, said microcomputer being adapted to perform an

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on-chip debugging function (figure 1; column 2, lines 22-34; column 1, lines 13-18; column 7, lines 46-48); a debug interface terminal disposed on said target board; a debugger connected to said microcomputer via said debug interface terminal, said debugger being adapted to perform debugging using the on-chip debugging function of said microcomputer (figure 5; column 2, lines 19-21; column 7, lines 16-31); and a break board connected to said target board, said break board being adapted to monitor signals output from said target board and to output a break signal when a predetermined break condition is satisfied (column 2, lines 55-58; column 7, lines 34-38; column 3, lines 44-49).

As per claim 4, Murray teaches the debugging device of Claim 3 wherein said break board includes a storage section storing said predetermined break condition (column 4, lines 46-49).

As per claim 5, Murray teaches the debugging device of Claim 4 wherein said predetermined break condition is written to said storage section via said target board from said debugger (figure 5; column 2, lines 19-21).

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: See attached PTO-892.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher S. McCarthy whose telephone number is (571)272-3651. The examiner can normally be reached on M-F, 9 - 5:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Beausoliel can be reached on (571)272-3645. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

csm
October 25, 2004


ROBERT BEAUSOLIEL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 210